

REMARKS/ARGUMENTS

Claims 1-3, 8, 10-15, and 17-21 were pending in this application before the present response. In the Office Action dated September 27, 2007, claims 1-3, 8, 10-15, and 17-21 stand rejected under 35 U.S.C. § 103(a).

No claims are amended herein. Claims 1-3, 8, 10-15, and 17-21 are now pending in this application. Applicants respectfully request reconsideration and allowance of all pending claims, in view of the following remarks.

Statement Concerning Common Ownership

U.S. Patent Application No. 09/736,617 and International Application No. PCT/US00/02855, published as PCT Application Publ. No. WO 00/50978 (hereinafter "Safadi") were, at the time the invention of U.S. Patent Application No. 09/736,617 was made, commonly owned by General Instrument Corporation.

Claim Rejection – 35 U.S.C. § 103

Claims 1-3, 8, 10-15, and 17-21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Safadi in view of various other references. The Applicants respectfully traverse this rejection, at least because the Safadi reference is disqualified from being applied against the claims of the present application.

The present application is assigned to General Instrument Corporation, and as shown on the face of the Safadi publication, the applicant therein is General Instrument Corporation. The present application and Safadi are commonly assigned and commonly owned.

MPEP § 706.02(I)(2) Section II establishes that a clear and conspicuous statement of common ownership, given by an attorney or agent of record in a separately labeled section of a response, alone is sufficient evidence to disqualify a patent application publication from being used in a rejection under 35 U.S.C. 103(a) against the claims of a pending application. Accordingly, the clear and conspicuous statement of Applicants, given above in the separately labeled "Statement Concerning Common Ownership," should alone be considered sufficient evidence to disqualify the Safadi reference from being used in a § 103(a) rejection against the claims of the present application.

In addition to the foregoing reasons, the Safadi reference is also improper because Applicants have submitted affidavits under Rule 131 from three of the co-inventors of the present invention, namely, Eric J. Sprunk, Reem Safadi, and Lawrence Vince. The Rule 131 affidavits were submitted on December 1, 2005. The Rule 131 affidavits establish that the instant invention was conceived and reduced to practice prior to the publication date of the Safadi reference. More particularly, the Rule 131 affidavits establish that the subject matter of the claimed invention was submitted to the law department of General Instrument Corporation no later than February 8, 2000, thus antedating the Safadi reference and removing it as prior art.

The Office Action, at page 3, finds the Rule 131 affidavits “insufficient because none of the name inventors are found on the invention of the instant application.” However, on March 22, 2005, Applicants filed a Petition to Correct Inventorship Under 37 CFR § 1.48(a) (the “Petition”) in the present application. In an interview with the Examiner on February 21, 2008, it was confirmed that the Petition had not been considered by the Examiner at the time of the Office Action. The Petition remains pending. Applicants respectfully submit that the Petition is valid under 37 CFR § 1.48(a), and should be promptly granted. In light of the fact that each of the inventors in the Safadi publication is also a co-inventor of the presently claimed invention, Applicants respectfully submit that the Rule 131 affidavits are sufficient.

The Office Action contends that “the invention record form does not distinguish which patent application the conceived invention is applied to” (page 3). Applicant respectfully submits that the present patent application is identified in the caption of each Rule 131 affidavit. In numbered section 2 of each affidavit, the declarant states, “Upon information and belief, John Okimoto and Douglas Makofka submitted a description of the invention, now claimed in **the above application**, in the form of a signed Invention Record, to the law department of General Instrument Corporation in January of 2000” (emphasis added). Accordingly, there is no ambiguity that the invention record form actually applies to the present application.

The Office Action further requires “an affidavit from one of the named inventors on the instant application” (page 3). As established by the Petition, the previously

submitted Rule 131 affidavits are from co-inventors of the present application. However, an additional Rule 131 affidavit from co-inventor John Okimoto is provided as requested.

The Office Action further states that the “invention disclosure form . . . clearly states page 5 (of each Affidavit) that the invention is currently being developed for the DCT5000 Resource Access Control,” and the Office Action claims that this “shows that only conception of the invention has been disclosed in the Affidavit and not an actual reduction to practice” (pages 2-3). Applicants respectfully disagree. The cited language from the invention disclosure form (“Is being developed”) was given in response to question number II.5, which reads, “Planned or actual use of invention.” Thus, the response to the question clearly established that a commercial **use** of the invention “[i]s being developed,” but the cited language does **not** state that the invention **itself** currently “[i]s being developed.” To the contrary, the invention disclosure form establishes that the invention “was developed” (questions number II.1 and II.4), and that it was constructively reduced to practice (see part III). Applicants respectfully submit that the invention disclosure form clearly shows a reduction to practice no later than February 8, 2000. Furthermore, at least in the additional Rule 131 affidavit from co-inventor John Okimoto, provided herewith, the alleged lack of clarity is remedied by the declarant’s statement concerning reduction to practice (paragraph 4).

Independent claims 1, 8, and 15 stand rejected as allegedly unpatentable over Safadi in view of Maillard et al., U.S. Patent No. 6,393,562 (hereinafter “Maillard”). As discussed above, Safadi is disqualified as a reference under 35 U.S.C. § 103(a). Maillard alone does not disclose each of the limitations of independent claims 1, 8, and 15. For at least the aforementioned reasons, independent claims 1, 8, and 15 are patentable over Maillard and each of the other cited references, either taken alone or in combination. Thus, the Examiner should withdraw the § 103 obviousness rejection as to independent claims 1, 8, and 15.

Claims 3-7, 10-14, and 17-21 depend, respectively, from independent claims 1, 8, and 15. For the previously stated reasons, independent claims 1, 8, and 15 are allowable. Since any claim that depends from an allowable independent claim is also allowable, the Applicants respectfully submit that the Examiner should also withdraw this rejection as to dependent claims 3-7, 10-14, and 17-21.

Conclusion

In view of the foregoing discussion, the Applicants believe that claims 1-3, 8, 10-15, and 17-21 are allowable over the cited art. The Applicants respectfully submit that all pending claims are in full condition for allowance, and earnestly request that the Examiner withdraw all objections and rejections of the claims and enter a Notice of Allowance at the earliest date possible.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Respectfully submitted,
DOUGLAS S. MAKOFKA, et al.

Date: February 27, 2008

BY: /Stewart M. Wiener/
Stewart M. Wiener
Registration No. 46,201
Attorney for Applicants

MOTOROLA, INC.
101 Tournament Drive
Horsham, PA 19044
Telephone: (215) 323-1811
Fax: (215) 323-1300